

REMARKS

This application has been carefully reviewed in view of the above Office Action and the above Advisory Action. Applicants appreciate the indication that objections to the drawings, specification and claims have been fully addressed. Applicants further appreciate indication that the double patenting rejection has been withdrawn. This response accompanies an RCE as the submission therefor. Reconsideration is requested in view of the following:

Amendments

Applicant has amended claim 42 to correct the spelling of "sample". This is an obvious typographical error that does not impact the meaning of the claim and requires no new search or consideration. Claim 1 has been amended in an attempt to further clarify the nature of the default audio sample. New claims 52-54 are submitted for consideration.

Interview Request

Applicants again request the courtesy of an interview and seek to advance prosecution of this application in an expedient manner. This request is reiterated and expanded upon later.

The Advisory Action

Applicants appreciate the further explanation provided in the Advisory Action, but maintains the position that the present claims are allowable.

The Advisory Action argues that Applicants' position regarding the contradictions in combining Walsh's reference with the prior art also disclosed in Walsh. The Advisory Action then proceeds to explain that "teaching away" is inapplicable to an anticipation analysis. It is noted that there is presently no rejection based on anticipation. All rejections are based upon obviousness; hence, the analysis provided in the Advisory Action would appear irrelevant. Moreover, it is noted that if the rejection based on

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Walsh takes Walsh's teachings and combines them with Walsh's discussion of the prior art as appears to be the case, there must be some articulated reasoning as to why it is logical to select from what amounts to two references and make a combination that is obvious. The clear teaching against in Walsh must be taken into consideration.

The Advisory Action further argues that Kelly's print driver as described by Kelly is in fact any "output preparing device", but fails to provide a sound explanation as to how this is relevant to the claims, since there is nothing asserted to be in the claims that would read on such an output preparing device. Moreover, the explanation provided is that an association table is created that associates a particular text term with a file. This table is then provided as an option from which the user can select to attach the file. Hence, the file is not a "default" music file as claimed, and the user would appear to have to use (or stumble upon) an appropriate key term in order to invoke the option of attaching the file. This is not what Applicants claim. Minor clarifying amendments have been made to assure that this distinction is given appropriate weight without affecting the intended scope of the claims. For example, claim 1 now uses the term "sole" to identify the sample. It is noted that claim 9 uses the term "each" to define that the sample is attached to each email. This is clearly not what Kelly has in mind and not what Kelly teaches to one having ordinary skill in the art.

The Advisory Action further argues twice against Applicants' assertion that motivation to combine the references can only be found using improper hindsight by mere insertion of the form paragraph 7.37.03 from the MPEP that cites McLaughlin without further explanation. While it is recognized that the SCOTUS has indicated that the so-called "TSM" test is not an absolute test for establishing obviousness in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1397 (2007), the requirement that there be an articulated reasoning for making the combination obvious has not been eliminated, and in fact has been endorsed. The Examiner still bears the burden of establishing *prima facie* obviousness and addressing the hindsight issue

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substantively. This requires, per the explicit endorsement in *KSR* of *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). Hence, the mere recitation of form paragraphs to support conclusions of obvious that do not provide an articulated reasoning in the face of arguments that there is teaching against and other factors does not satisfy the requirements for establishment of *prima facie* obviousness.

The Office has not shown that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 745 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). To the contrary, the only place one finds such suggestion is in the Applicants’ specification. Thus, it is clear that the Examiner has relied on impermissible hindsight in making the determination of obviousness. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1141, 227 USPQ 543, 550 (Fed. Cir. 1985); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”).

Instead, it is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed.

Cir. 1988) and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985).

It is additionally noted that in order to establish *prima facie* obviousness, the Office is required to consider each and every word of the claims and each claimed feature must be considered in the arrangement claimed. The Office fails to meet this burden in the present application.

It is further noted that the Office Action and Advisory Action fail to address many of the arguments and provide articulated reasoning as required in order to establish *prima facie* obviousness. Reconsideration is respectfully requested.

The Walsh Reference

To briefly summarize, the Walsh reference of record relates to an email system in which "indicators" such as a predetermined character or text such as the word "attached" is present in the body of the email document. If so, the user is prompted to provide "a file name and/or location of the attachment file". The processor then attaches the specified file. (see e.g., col. 2, line 59 through col. 3, line 62). In an alternative embodiment, the user creates an association table that relates terms used in an email with specific attachments that are associated with phrases used in the email (see e.g., col. 6., lines 1-18). Hence, the option of attaching the file as taught is only available if the right indicator appears in the message; hence, the attachment is not attached to each message and the attaching happens by virtue of more and different actions than are called out in the claims.

The Kelly Reference

This reference has been extensively discussed in prior responses. To briefly summarize, the Kelly reference describes use of an API printer driver-like program. A user can create a file from any of a number of applications, and then invoke a "print" command. The print command presents the user with printer options from which the API printer driver-like program is invoked. In one embodiment, the API printer driver-

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like program actually invokes an email application. Thus, after creation of a document or other file, the user is able to email a representation of the file (e.g., a bitmap image) to a recipient. Note carefully that the program associated with the email attachment is used to invoke the email program, whereas, in the claims the attachment is evoked from within the email application program.

While Kelly does mention file types such as MP3, It is not so clear what this really has to do with the operation of the Kelly reference since no discussion is provided of interaction of Kelly's software with a music sample. It is presumed that from a program that interacts with the music sample, one would invoke a print command (although a print command does not appear logical from such a program) and from the print command, the email application could be invoked. Taking the broader interpretation provided by Kelly, that the printer is to be interpreted as an **"output preparing device"**, there has been no reasoning articulated for what part of the claim reads on such an output preparing device or even what such a device might be. Clearly, Kelly is not in any way enabling as to any use in connection with a music sample.

The Rejections

Claims 1, 2 8-10, 17, 18, 24, 25, 36, 37 and 41-43 were rejected as obvious based on the combination of Walsh and Kelly of record.

In section 7, the Office submits that Walsh teaches "establishing a file to be a predetermined default file to be used in conjunction with an email program". Applicant submits this to be an incorrect interpretation of Walsh and the claim language. At the cited passage of Walsh (col. 6, lines 1-14), Walsh describes "a fifth storage device" storing an "association table" that associates "terms or phrases" with "filenames and/or locations". This permits the processor to identify one of the "terms or phrases" within the body of an email document and as a result, "prompt the user whether to attach" a document associated in the association table to the email. The asserted teaching of a default file to be used in conjunction with the email program is misinterpreted in the context of the remainder of the claim in that there is in fact no establishing a predefined

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default audio sample to be used as an audio sample for an email application program as claimed (to paraphrase without intent of imposing additional limitations). It would not be contradictory to the teachings of Walsh for an email message to prompt the user to select from multiple files to attach; therefore, Walsh does not establish a default audio sample as claimed.

Kelly is submitted by the Office to teach “automatically attaching a file to an email message” at col. 5, lines 12-19 “where that file can be audio” (col. 6, lines 38-41). However, as has been pointed out previously, Kelly’s email program is invoked as a printer driver (or output preparing device – whatever that is) from an application program. No explanation has been provided as to how one invokes a print program to print a music file in order to invoke the Kelly’s email program and send the music file! Moreover, no explanation has been provided for what an output preparing device is other than a printer or how the claims can be read thereon. The asserted teaching simply is not there.

As noted in the prior response, the Office Action asserts that “*Kelly teaches automatically attaching a file to an email message (Kelly, col. 5, lines 12-19)*”. However, it is submitted that at best something akin to the reverse actually happens. In fact, Kelly teaches invoking an email application from a program that manipulates a file that is to become the attachment! This is quite different than the claims since certain of the claims call for “*within the email application program, receiving a single command from the sender to attach the predefined default audio sample; and responsive to the sender’s command within the email application program to attach the predefined default audio sample, attaching the predefined audio sample to the electronic mail message*”. In fact, none of the cited art teaches, suggests or implies anything about an email application program having a default audio sample as taught by Applicants, and it is improper to use Applicants’ teachings as a template for a hindsight reconstruction of the invention from the prior art.

The undersigned reiterates that per *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), as explicitly endorsed by the Supreme Court in - “[R]ejections on obviousness

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grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). The Office fails to explain how a table of terms that are associated with files can be interpreted as a default audio sample. The Office further fails to explain how Kelly can be interpreted to automatically attach a music sample file to an email message, when in fact the email program of Kelly is invoked as a printer driver from the application software (see col. 3, line 63 through col. 4, line 12.) Would one go to a music player and invoke a printer to print an audio file? It simply doesn’t make sense. The office further fails to explain what Kelly means by the term “output preparing device” and offers no explanation as to what the relevance of such a device is to the claims.

Let us consider claim 1 for a detailed example as illustrated below:

Claim Language	Office Position	Remarks
A method of transmitting an audio sample using electronic mail, comprising:	“Walsh teaches a method of transmitting an audio sample using electronic mail...” “Walsh does not explicitly teach use of an audio sample.” (Section 7)	Office Action is contradictory but admits Walsh does not teach an audio sample and relies on Kelly.
establishing an audio sample to be a predefined sole default audio sample to be used in conjunction with an email application program;	Asserts this to be taught in col. 6, lines 1-14.	Walsh describes an association table that stores “terms or phrases and corresponds them to respective file names and/or locations. The table is used by the email application, but <u>there is no sole default audio sample associated with the email application.</u> There is, in fact, no <u>default file associated with the email program</u> except possibly the association table, which stores associations between words used in the

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		email and files. There is also no prohibition in the teachings against multiple files, in which none of them constitutes a sole default audio sample file.
within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient;	Col. 3, lines 27-37	Walsh describes an email application program, but the email application invokes a prompt as a result of locating indicators in the email message. Such indicators lead to further actions of attaching a file, but fail to meet the claim feature of a sole default audio sample.
within the email application program, receiving a single command from the sender to attach the predefined sole default audio sample; and	Asserted to be disclosed in Walsh col. 3. Lines 38-62.	Walsh describes his basic concept of finding identifiers such as the word "attached" or special characters that leads one to know there is an attachment. Walsh then describes that the user is prompted to provide a filename and/or location for the attachment. There is no indication that this occurs as a result of a single command from the user.
responsive to the sender's command within the email application program to attach the predefined sole default audio sample, attaching the predefined audio sample to the electronic mail message.	Asserted to be disclosed in Walsh col. 3. Lines 38-62. Kelly is submitted to disclose automatically attaching a file to an email and mentions audio file formats.	There is no indication that this occurs as a result of a single command from the user. Since the user is selecting a filename and/or location, the assertion that Walsh has a predefined "sole default" audio sample that is attached is not supported by the disclosure.

		<p>There is no explanation in Kelly as to how his teachings would apply to audio samples since Kelly describes a printer driver-like program that is invoked from an application program – but, how does one “print” an audio file?</p> <p>No articulated reasoning has been supplied to explain how Kelly is to be modified to work from within an audio program or why this combination is obvious.</p> <p>No articulated reasoning is provided as to the meaning of an output preparing device and how the claim language reads on such.</p> <p>No articulated reasoning has been provided as to why invoking attachment of a sole default audio sample from within an email application program is obvious in light of Kelly’s teachings of invoking a printer driver from a program that manipulates the attachment in order to send the attachment. Note that the three final claim features require operation from within the email application program, and Kelly invokes the email function from another program.</p>
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In view of the above it is clear that claim 1 has not been established to be *prima facie* obvious in view of Walsh and Kelly. Essentially, the Office combines Walsh with the prior art which Walsh deems unacceptable. Hence, the Walsh reference does not contain a disclosure of elements arranged as claimed by Applicants, and the Office fails to provide an articulated reasoning to explain the combination in the face of clear teaching away. Reconsideration and allowance are respectfully requested.

All claims dependent from claim 1 (claims 2-8) are submitted to be non-obvious for at least the same reasons. Reconsideration and allowance are respectfully requested.

Specifically regarding claim 8, the Office references col. 1, lines 45-50. It is respectfully noted that this section is discussing the prior art techniques to Walsh which Walsh has deemed unsatisfactory in col. 1, lines 50-55 and col. 2, lines 17-26. It would appear contradictory to combine Walsh's teachings with those of the prior art having problems to which Walsh states that "A solution to these drawbacks is needed". (col. 2, line 39. Reconsideration and allowance are respectfully requested.

Regarding independent claim 9, many of the above arguments are applicable, however, this claim even further distinguishes over the cited Walsh and Kelly references. Claim 9 recites the requirement of "automatically attaching the predefined default audio sample to each electronic mail message generated by the sender" (emphasis added). The Office admits that Walsh does not disclose automatically attaching an audio sample to an email, but submits in section 10 that Kelly teaches "within the email application program, automatically attaching an audio sample to each electronic mail message generated by the sender." (col. 6, lines 38-41 and col. 5, lines 12-19). Applicant finds no such teaching in Kelly. Again, Kelly's email application is invoked from another application program by use of a printer driver. Kelly falls far short of teaching, disclosing or suggesting that a default audio sample is automatically

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attached to each email message generated by the sender. There simply is no teaching of attaching a default audio sample to each email message in the art. Reconsideration and allowance are respectfully requested.

All claims dependent from claim 9 (claims 10-16) are submitted to be non-obvious for at least the same reasons. Reconsideration and allowance are respectfully requested.

Regarding claim 24, the Office again asserts the claim to be obvious in view of Walsh combined with Kelly. The Office again asserts that Walsh establishes a predetermined default file used with the email program – but the Office fails to establish any teaching or suggestion or provide any articulated reasoning based on evidence of a “means for establishing an audio sample to be a predefined default audio sample used in conjunction with the electronic mail application” as claimed. The Office further fails to establish any teaching or suggestion or provide any articulated reasoning based on evidence of a “program means forming a part of the electronic mail application, for attaching the predefined default audio sample to all electronic mail documents sent by the sender.”

All claims dependent from claim 24 (claims 25-30) are submitted to be non-obvious for at least the same reasons. Reconsideration and allowance are respectfully requested.

Regarding the rejection to claims 10, 17, 18, 25, 36, 37, 41-43 and 48, these claims are submitted to be allowable for at least the same reasons noted above.

Claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31-35, 38-40 and 44-51, the Office Action rejects these claims based on the above combination of Walsh and Kelly as well as Fritsch. The above remarks regarding the combination of Walsh and Kelly are equally applicable. The Fritsch reference describes a system and method for online music purchase from a music vendor's web site. While Fritsch discloses online music

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purchase, there is no teaching or suggestion to link to the web site for purchase by virtue of a music sample sent or received via email. While the motivation to sell music and increase revenue described at the bottom of page 7 of the office action are not in dispute, the combination of references that produce a default audio sample is only motivated by the teachings of the present application. The above remarks regarding the failings in teachings of Walsh and Kelly preclude a determination of *prima facie* obviousness in taking the next step of providing a mechanism for purchase of the music once the music sample is distributed. Such motivation can only be found using improper hindsight. Similar arguments weigh against the obviousness of linking to streaming music in the absence of a hindsight reconstruction of Applicant's other claim features.

It is further submitted that the cited art fails to disclose an enterprise email server that handles a task of attaching audio samples to outbound email is neither taught nor suggested by the cited art and no articulated reasoning has been presented that explains how one of ordinary skill in the art would find it obvious to provide an enterprise email server that provides "program means, running on the enterprise email server, for attaching the predefined default audio sample to an electronic mail document sent from the electronic mail application to the recipient" for example as called out in claim 31. Again, only hindsight reasoning provides the teachings to make the proposed combination. Reconsideration and allowance of these claims are respectfully requested.

Thus, the rejections to claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31-35, 38-40 and 44-51 are improper. Further, Applicant disputes that certain of these claims do not define any new limitations and submits that the Office Action is deficient for failure to fully consider each element of each claim. Reconsideration and allowance are respectfully requested.

Regarding the rejection to claims 4, 7, 12, 15, 20, 23, 27 and 30, these claims were rejected based on the combination of Walsh, Kelly, Fritsch and further in view of Kang. Kang is presented for teachings of affinity credits.

Again, the above arguments are submitted to be applicable to this rejection. While affinity credits for purchase are known, it is again hindsight reconstruction to couple the award of affinity credits with sending an email. In the present application, Office has taken a path of individually searching for individual elements and attempted to construct Applicant's claims therefrom, but has failed to provide any solid reasoning as to why one of ordinary skill in the art would have found it obvious to make the proposed combinations and modifications to arrive at the claimed invention. Reconsideration and allowance are respectfully requested.

Applicant further wishes to point out that *In re Glass*, 472 F.2d 1388, 1392(C.C.P.A. 1973) is believed to remain valid case law. This case states that "If even a single claim limitation is not taught or suggested by the prior art, then that claim cannot be obvious over the prior art." In the present case, none of the cited art teaches anything about a "default audio sample" associated with an email application program as claimed. Accordingly, the claims calling for such an element cannot be *prima facie* obvious in view of the cited art. The Office has further failed to find numerous other claim features in the combination claimed. Reconsideration and allowance are respectfully requested.

Applicants hereby deny that any claim fails to define new limitations over their parent claims as asserted in multiple locations in the Office Action, but feels that in view of the above deficiencies in the current rejections, there is no need to provide detailed explanation of each feature given the Office's disregard for numerous claim features without comment. The Office is required to examine all of Applicant's claims. A blanket statement that claims do not define new limitations is believed adequate to render the

Office Action defective and in fact to render the finality of the Office Action improper. Reconsideration and allowance of all claims are respectfully requested.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date.

Request for Interview

The present application has been pending since 2001. It is respectfully submitted that the present Office Action and Advisory Action fails to establish *prima facie* obviousness of any claim. It is respectfully submitted that this application is in condition for allowance in its present form. However, if there are further minor amendments that can be made to place the application in better condition, the undersigned is happy to consider them. It is submitted that the claims should be allowed and an interview is appropriate to facilitate matters. Hence, the undersigned respectfully requests the courtesy of a telephone interview to advance the present prosecution. The undersigned can be reached at the telephone number below.

Respectfully submitted,

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Dated: 7/29/2008

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